

REMARKS

Applicants have canceled claims 5, 10, and 11 without prejudice to introduction in a subsequent application or reintroduction in the present application. Applicants have added new claims 25-34. Support for new claims 25-34 is found in paragraphs [0039], [0074], [0103], and [0104] as well as elsewhere throughout the specification of the published application (US 2005/0121044). Additional support is found in Figures 1-3. Claims 19-22 are withdrawn in view of the Restriction Requirement mailed October 2, 2006. As result, claims 1-4, 6-9, 12-18, and 23-34 are pending in the application.

Claim 3 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent 5,789,337 to Haruta et al. (hereinafter "Haruta"). Claims 4-11 are rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent Application Publication 2003/0131859 to Li et al. (hereinafter "Li"). Claims 12-18, 23, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Haruta. Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Haruta as applied to claims 12-18 above and further in view of United States Patent 5,727,573 to Meier et al. (hereinafter "Meier").

Applicants respectfully request reconsideration of the present application in view of the following Remarks.

Claim 3 and 35 U.S.C. § 112, Second Paragraph

Claim 3 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the language of claim 3 is such that it cannot be definitively determined whether Applicants intend to claim particles comprising (1) any of the various metals or mixtures of the various metals or (2) a mixture of all the enumerated metals. Applicants have amended claim 3 to clarify that particles comprise (1) any of the various metals or mixtures of the various metals.

In view of the foregoing amendment, Applicants respectfully assert that claim 3 is compliant with the provisions of § 112, second paragraph, and respectfully request that the present rejection be withdrawn.

Claims 1-3 and 35 U.S.C. § 102(b)

The rejection of claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Haruta is respectfully traversed.

Applicants have amended claim 1. Support for the present amendment to claim 1 can be found in paragraph [0039] as well as elsewhere throughout the specification of the published application (US 2005/0121044). Haruta does not describe or teach a catalyst composition wherein the substrate has an average diameter ranging from 0.05 to 2.0 mm. As a result, claim 1 is not anticipated by Haruta and Applicants respectfully request that the Examiner withdraw the present rejection. As claims 2 and 3 depend from and further limit claim 1, Applicants respectfully assert that claims 2 and 3 are not anticipated by Haruta and respectfully request that the Examiner withdraw the rejection of these claims as well.

Claims 4-11 and 35 U.S.C. § 102(e)

The rejection of claims 4-11 under 35 U.S.C. § 102(e) as being anticipated by Li is respectfully traversed.

Applicants have amended claim 4. Support for the present amendment to claim 4 is found in paragraphs [0100] through [0103] as well as elsewhere throughout the specification of the published application (US 2005/0121044). Additional support is found in Figure 1.

Li does not describe or teach a smoking article comprising a filter element comprising a catalyst composition chamber having a catalyst composition disposed therein. Li provides catalyst composition in the cut filler of the smoking article. As a result, Applicants respectfully assert that claim 4 is not anticipated by Li and respectfully request that the Examiner withdraw the present rejection. As claims 6-9 depend from and further limit claim 4 or an intervening dependent claim, Applicants respectfully assert that claims 6-9 are not anticipated by Li and respectfully request that the Examiner withdraw the rejection of these claims as well.

Claims 12-18, 23, and 24 and 35 U.S.C. § 103(a)

The rejection of claims 12-18, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Haruta is respectfully traversed. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 9891, 180 USPQ 580 (CCPA 1974).

A. Claims 12-18

As provided above, Li does not teach or suggest a smoking article comprising a filter element comprising a catalyst composition chamber having a catalyst composition disposed therein. Moreover, Haruta does not cure the deficiencies of Li as Haruta does not address a smoking article at all.

B. Claims 23 and 24

As provided above, Haruta does not teach or suggest a catalyst composition comprising ultrafine particles disposed on a substrate, the substrate having an average diameter ranging from 0.05 mm to 2.0 mm. Moreover, Li does not cure the deficiencies of Haruta as Li does not teach or suggest a catalyst composition comprising ultrafine particles disposed on a substrate, the substrate having an average diameter ranging from 0.05 mm to 2.0 mm.

In view of the foregoing, Applicants respectfully assert that claims 12-18 and 23-24 are patentable over Li in view of Haruta and respectfully request that the Examiner withdraw the present rejection.

Claim 7 and 35 U.S.C. § 103(a)

The rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Haruta as applied to claims 12-18 above and further in view of Meier is respectfully traversed.

For reasons consistent with those provided in the discussion of claims 4-11 and 12-18, the combination of Li and Haruta does not teach or suggest a smoking article comprising a filter element comprising a catalyst composition chamber having a catalyst composition disposed therein. Moreover, Meier does not cure the deficiencies of Li and Haruta. Meier also does not teach or suggest a smoking article comprising a filter element comprising a catalyst composition chamber having a catalyst composition disposed therein. As a result, Applicants respectfully assert that claim 7 is patentable over Li in view of Haruta and further in view of Meier and respectfully request that the Examiner withdraw the present rejection.

New Claims 26-34

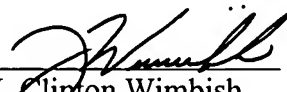
Applicants have added new claims 26-34. Support for new claims 26-34 is provided above. For reasons consistent with those provided herein, Applicants respectfully assert that new claims 26-34 are patentable over the applied prior art and the prior art of record in the application.

CONCLUSION

In view of the foregoing, a favorable Office Action is respectfully solicited. The Examiner is respectfully invited to contact J. Clinton Wimbish at 704.338.5021 to discuss any matter related to the present application.

Respectfully submitted,

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Date


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